

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

AVANT LOCATION TECHNOLOGIES LLC,

Patent Owner.

Patent No. 8,738,040

Filing Date: March 27, 2007

Issue Date: May 27, 2014

Inventor: Carlos Alberto Perez Lafuente

Title: METHOD AND SYSTEM FOR MONITORING A MOBILE STATION
PRESENCE IN A SPECIAL AREA

**PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL OF INSTITUTION**

Case No. IPR2025-01256

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Third Amended Docket Control Order (Dkt. 27), <i>Avant Location Techs. LLC v. Ecobee Techs. ULC d/b/a ecobee</i> , Case No. 2:23-cv-00354-JRG-RSP (E.D. Tex. October 17, 2025)
2002	Complaint (Dkt. 1), <i>Avant Location Techs. LLC v. Apple Inc.</i> , Case No. 2:24-cv-0757-JRG (E.D. Tex. Sept. 13, 2024)
2003	Complaint (Dkt. 1), <i>Avant Location Techs. LLC v. Apple Inc.</i> , Case No. 7-25-cv-00445-ADA (W.D. Tex. Oct. 1, 2025)
2004	<i>Ecobee Techs. ULC's Invalidity</i> and Subject Matter Eligibility Contentions in <i>Avant Location Techs. LLC v. Ecobee Techs. ULC d/b/a ecobee</i> , Case No. 2:23-cv-00354-JRG-RSP (E.D. Tex.), dated March 14, 2025
2005	Apple Inc.'s First Amended Invalidity and Patent-Eligibility Contentions in <i>Avant Location Techs. LLC v. Apple Inc.</i> , Case No. 2:24-cv-0757-JRG (E.D. Tex.), dated July 14, 2025
2006	Email Correspondence between Julian Pymonto (Counsel for Patent Owner in the EDTX Apple Litigation / WDTX Apple Litigation) and Andrew Danford (Counsel for Petitioner in the EDTX Apple Litigation / WDTX Apple Litigation)
2007	First Amended Complaint (Dkt. 1), <i>Avant Location Techs. LLC v. Apple Inc.</i> , Case No. 7-25-cv-00445-ADA (W.D. Tex. Nov. 14, 2025)

I. INTRODUCTION

Pursuant to the Director’s March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management, Avant Location Technologies LLC (“Patent Owner”) files this Request for Discretionary Denial of Institution.

On September 11, 2025, Apple Inc. (“Petitioner”) submitted a Petition (Paper 2, “Petition” or “Pet.”) requesting *inter partes* review (“IPR”) of U.S. Patent No. 8,738,040 (Ex. 1001, the “’040 Patent”), challenging Claims 1-14 (the “Challenged Claims”).

The Petition identifies co-pending district court litigations *Avant Location Techs. LLC v. Ecobee Techs. ULC d/b/a ecobee*, Case No. 2:23-cv-00354-JRG-RSP (E.D. Tex.) (“Ecobee Litigation”), with a trial date set for May 18, 2026 (Ex. 2001) and *Avant Location Techs. LLC v. Apple, Inc.*, Case No. 7-25-cv-00445-ADA (W.D. Tex.) (“WDTX Apple Litigation”)¹. Pet. at 105; Paper No. 5 (“Patent Owner’s Mandatory Notice”), at 2. With Patent Owner’s Preliminary Response due

¹ Patent Owner had previously filed a complaint (Ex. 2002) against the ’040 Patent in *Avant Location Techs. LLC v. Apple Inc.*, Case No. 2:24-cv-00757-JRG (E.D. Tex.) (“EDTX Apple Litigation”), which was joined with the Ecobee Litigation, but dismissed by Patent Owner and re-filed (Ex. 2003) in the Western District of Texas as the “WDTX Apple Litigation” on October 1, 2025.

December 17, 2025, institution of any grounds will result in the issuance of a Final Written Decision (“FWD”) by March 17, 2027.

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a) for at least the following reasons: (i) the parallel WDTX Apple Litigation exists between the same parties or real-parties-in-interest; (ii) the Ecobee Litigation and WDTX Apple Litigation involve the same subject patent (the ’040 Patent) with the same claims; (iii) the Ecobee Litigation Court’s trial on May 18, 2026 will be *almost ten months before* the projected statutory deadline for FWD; (iv) Patent Owner has heavily invested in the Ecobee Litigation² with the deadline for the completion of fact discovery on October 7, 2025 and the completion of claim construction briefing due before the December 12, 2025 deadline for an institution decision; and (v) the ’040 Patent issued on May 27, 2014 (with a priority date of March 28, 2006 based on EP 06111804), has been in force for over 11 years, and settled expectations have been created.

² The parties were also heavily invested in the EDTX Apple Litigation prior to refiling as the WDTX Apple Litigation, and each party has agreed to retain its own confidential discovery from the EDTX Apple Litigation to serve and streamline discovery in the WDTX Apple Litigation. Ex. 2006.

For the reasons set forth herein, the Director should exercise discretion to deny the Petition.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel district court litigations collectively necessitate denial of the Petition under the Board’s precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (considering (a) “whether the petitioner and the defendant in the parallel proceeding are the same party”; (b) “overlap between issues raised in the petition and in the parallel proceeding”; (c) “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision”; (d) “investment in the parallel proceeding by the court and the parties”; (e) “whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted”; and (f) “other circumstances that impact the Board’s exercise of discretion, including the merits.”).

As set forth below, these factors collectively demonstrate that efficiency and integrity of the AIA are best served by denying review. First, the Petitioner is a Defendant in one of the parallel proceedings. *See infra* Section II.A. Second, both the Ecobee Litigation and the WDTX Apple Litigation involve the same claims at

issue in the Petition. *See infra* Section II.B. Third, trial in the Ecobee Litigation is set for May 18, 2026, over ten months prior to the projected statutory deadline for a Final Written Decision of this Petition on March 17, 2027. *See infra* Section II.C. Fourth, the parties have invested significant resources in developing legal and factual issues of validity and infringement in both the Ecobee Litigation and WDTX Apple Litigation and will have invested substantially more resources before any decision on this Petition. *See infra* Section II.D. Finally, there are settled expectations regarding the '040 Patent, as it was granted over 11 years ago. *See infra* Section II.E.

Accordingly, the Director should exercise discretion under § 314(a) and deny the Petition because institution of this proceeding would not be consistent with the objective of the AIA to “provide an effective and efficient alternative to district court litigation.” *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

**A. The Parallel District Court Litigation and the Petition
Involve the Same Parties**

As Petitioner notes, there exists a parallel district court litigation between the same parties regarding the same subject patent (the '040 Patent). Pet. at 105; Paper No. 5 (“Patent Owner’s Mandatory Notice”), at 2. Petitioner is a party to the WDTX

Apple Litigation captioned as *Avant Location Techs. LLC v. Apple, Inc.*, Case No. 7-25-cv-00445-ADA (W.D. Tex.). The WDTX Apple Litigation (like the EDTX Apple Litigation before it) involves causes of action asserting the '040 Patent against Petitioner's products, which include Apple products that implement Find My, which include, but are not limited to, iPhone, iPad, iPod Touch, Apple Watch, Mac, AirPods, AirTag, Apple Pencil, and Apple Vision Pro. *See* Ex. 2003, at 5-6; Ex. 2002, at 12-13. Petitioner waited nearly one year after Patent Owner filed its Complaint against Petitioner in the EDTX Apple Litigation on September 13, 2024 before filing its Petition on September 11, 2025. Ex. 2002.

Accordingly, this factor weighs strongly in favor of discretionary denial.

B. The Parallel District Court Litigations Involve Substantially the Same Claims

There is overlap between the claims and grounds at issue in this Petition and the Ecobee Litigation and WDTX Apple Litigation because the Petition challenges the claims asserted in the Ecobee Litigation and WDTX Apple Litigation under the same grounds. In particular, the Invalidity Contentions in the Ecobee Litigation challenge the Challenged Claims using the U.S. Patent Application Publication No. US 2006/0135174 ("Kraufvelin") reference (Ex. 1006, 12-18) and the Invalidity

Contentions in the EDTX Apple Litigation³ challenged the Challenged Claims using Kraufvelin, U.S. Patent Application Publication No. US 2005/0070283 (“Hashimoto”) (Ex. 1008), U.S. Patent No. 6,230,017 (“Andersson”) (Ex. 1007), U.S. Patent Application Publication No. US 2003/0134636 (“Sundar”) (Ex. 1017), U.S. Patent Application Publication No. US 2001/0037211 (“McNutt”) (Ex. 1014) references (Ex. 2005, 9-12), which are the same references used by the Petitioner in this proceeding. Pet. at 26-27.

“In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Accordingly, this factor weighs strongly in favor of discretionary denial.

C. Proximity of the District Court’s Trial Date

The proximity of the Ecobee Litigation’s trial date to the Board’s projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial. The trial in the Ecobee Litigation is scheduled for May 18, 2026. Ex. 2001. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected

³ These are likely the same grounds/references that Petitioner will use to challenge the Challenged Claims in the WDTX Apple Litigation.

statutory deadline for a Final Written Decision of this Petition is March 17, 2027.⁴ As the Ecobee Litigation’s trial will be *over ten months before* the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Supercell Oy v. Gree, Inc.*, IPR2020-00513, Paper 11 at 10-12 (P.T.A.B. June 24, 2020) (denying institution where the jury trial was scheduled to conclude approximately ten months before the statutory deadline); *Edward LifeSciences Corp. v. Evalve, Inc.*, IPR2019-01479, Paper 7, at 6-13 (P.T.A.B. Feb. 26, 2020) (denying institution where jury trial would conclude more than nine months before a final decision would be due); *Samsung Elecs. Am., Inc. v. Uniloc 2017 LLC*, IPR2019-01218, Paper 7, at 7-10 (P.T.A.B. Jan. 7, 2020) (denying institution where jury selection was scheduled for approximately six months before trial in the Board proceeding would conclude); *Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial

⁴ Patent Owner will file a timely preliminary response on December 17, 2025. The statutory deadline for institution is March 17, 2026, “three months after receiving a preliminary response to the petition under section 313.” *See* 35 U.S.C. § 314(b)(1). If instituted, the statutory deadline for a Final Written Decision is March 17, 2027, “not later than 1 year after the date on which the Director notices the institution of a review.”

was scheduled to conclude “several months,” before a final decision would be due); *Cisco Sys., Inc.*, IPR2020-00122, Paper 15 at 8 (“Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.”); *Cisco Sys., Inc. v. Estech Sys., Inc.*, IPR2021-00329, Paper 13 at 7-15 (P.T.A.B. Jul. 6, 2021) (denied when two related trials predate FWD by eleven months and seven months, respectively); *F5 Networks, Inc. v. WSOU Invs., LLC*, IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC*, IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc’ns LLC*, IPR2025-00123, Paper 12, at 6-7 (P.T.A.B. Apr. 22, 2025) (denied when trial predates FWD by six months). The ten-month differential between the May 2026 trial date and the March 2027 FWD justifies discretionary denial.

Accordingly, this factor weighs strongly in favor of discretionary denial.

D. Significant Investment and Petitioner’s Delay in Filing the Petition

The parties’ investment in the parallel Ecobee Litigation weighs strongly in favor of discretionary denial. In the Ecobee Litigation, the parties have already

exchanged infringement and invalidity contentions, and the parties' Markman hearing is scheduled December 4, 2025. The deadline for substantial completion of document production will pass on December 15, 2025. Ex. 2001.

By the March 17, 2026 statutory deadline for an institution decision, the parties will have completed the Markman hearing, fact discovery, expert discovery, almost all briefing of dispositive motions, and pretrial disclosures. *See id.* A trial date is set for May 18, 2026, which is six months away. *Id.*

Additionally, the parties' investment in the parallel WDTX Apple Litigation weighs strongly in favor of discretionary denial. Prior to being dismissed and refiled in the Western District of Texas on October 1, 2025, Patent Owner and Petitioner shared a joined schedule with the Ecobee Litigation in the EDTX Apple Litigation and had exchanged infringement contentions (including with source code), invalidity contentions, and claim constructions for disputed terms. After refiled in the Western District of Texas, Petitioner and Patent Owner agreed, for the WDTX Apple Litigation to respectively retain their own confidential information, including "Apple's discovery responses, documents, and source code print outs . . . as well as any documents [the Patent Owner] served on Apple that include Apple confidential information / source code (e.g., ALT's source code amended infringement contentions)." Ex. 2006. Accordingly, the parties have also already invested heavily

in the WDTX Apple Litigation.

The substantial investments in the Ecobee Litigation, EDTX Apple Litigation, and WDTX Apple Litigation weigh strongly in favor of denial of institution.

E. Settled Expectations of the Parties

The '040 Patent was granted May 27, 2014, over 11 years before Petitioner brought this action, and claims priority to an application from March 28, 2006, which is over 19 years before Petitioner filed its Petition. Ex. 1001. As such, Patent Owner has settled expectations at this point. The Board has previously discretionarily denied institution because “the challenged patent has been in force almost eight years, creating settled expectations.” *Dabico Airport Sols. Inc. v. AXA Powers Aps*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025). The Board also noted that “the longer the patent has been in force, the more settled expectations should be” and equated this approach to the six-year damages period related to filing infringement lawsuits. *Id.* at 3. The situation is no different here, as “actual notice of a patent or of possible infringement is not necessary to create settled expectations.” *Id.* This is exacerbated by the fact that Petitioner did have actual notice of the '040 Patent and possible infringement as early as February 6, 2019, when Afirma Consulting & Technologies, S.L. (“Afirma”), the original assignee of the '040 Patent, provided affirmative notice to Apple regarding Afirma’s portfolio of 16 granted patents, including the '040 Patent, along with a PowerPoint presentation,

including introductory information, exemplary use cases, competitive IP analysis, a technical framework, and a business plan regarding the same. Ex. 2007, ¶ 25.

When viewing these factors together, the Petition should be denied in the Director's discretion under 35 U.S.C. § 314(a).

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition in its entirety.

Respectfully submitted,

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 2,073 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

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CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2007 have been served on Petitioner's counsel of record as follows:

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